

Serial No. 10/824,500

Attorney Docket No. 01-619

REMARKS

Claims 1-9, 11-22, 24-25 and 27-32 are pending. Claims 10, 23 and 26 are canceled.

The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

One of the references cited in the Office Action, European Patent Pub. No. EP1101670, Losey ("Losey") is not listed in any Notice of References Cited, Form PTO-892. Accordingly, Losey is not yet of record. The examiner is respectfully requested to formally make Losey of record by listing Losey in a Notice of References Cited, Form PTO-892, as required, and forwarding a copy of the Form to the undersigned at the earliest opportunity.

Counsel for the applicant thanks the examiner for the courtesy of the telephone interview conducted on June 18, 2007. The following remarks incorporate a summary of issues discussed during the telephone interview

Claims 24-25 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 6,232,874, Murphy ("Murphy"). Claims 1, 3, 6-16, 20-23, 27 and 30-32 were rejected under 35 USC 103(a) as being unpatentable over Murphy in view of U.S. Patent No. 5,513,107, Gormley ("Gormley"). Claims 2, 4, and 17-18 were rejected under 35 USC 103(a) as being unpatentable over Murphy in view of Gormley, further in view of U.S. Patent No. 6,711,474, Treyz et al. ("Treyz"). Claims 5 and 19 were rejected under 35 USC 103(a) as being unpatentable over Murphy and Gormley further in view of European Patent Pub. No. EP1101670, Losey ("Losey"). Claims 28-29 were rejected under 35 USC 103(a) as being unpatentable over Murphy and Gormley, further in view of UK Patent Pub. No. 2298071, Weskow ("Weskow"). Insofar as the rejections may be applied to the claims as amended, the rejection is respectfully traversed for reasons including the following, which are provided by way of example.

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Independent claim 1 is directed to "a navigation device for a vehicle." Claim 1 as amended recites in combination, for example, "a storing unit configured for storing personal position information pertinent to a user of the vehicle, for navigating; ... a commanding unit configured to generating a command of one of: a permitting command ...; and (ii) an unpermitting command for unpermitting the given function to thereby protect the stored personal position information from being disclosed when the navigation privacy mode is activated, although the navigation device can remain unchanged in any function other than a function needing a use of the stored personal position information" (See also independent claims 11, 13 and 24 as amended.)

For instance, when the valet mode is determined to be optionally turned on, an embodiment can enter privacy personal position information mode. Thereby, the system can execute a featured function to protect the user's personal position information (such as the user's home) for being leaked or being disclosed. (E.g., FIG. 3, S20-S70.)

Furthermore, in accordance with the recited invention, and as further recited in claim 9, disabling the given function using the personal information still allows the vehicle itself to remain unchanged or remain effective in any state or any function (e.g., travel movement and in-vehicle accessories' operation), other than the navigation device.

On the other hand, without conceding that Murphy discloses any feature of the present invention, Murphy is directed to a system for restricting use of a vehicle by a selected operator to permitted time intervals and permitted vehicle travel corridors (Abstract).

Gormley is directed to controlling operating subsystems of a motor vehicle. According to Gromley. For example, if a valet is parking the vehicle, limited operating parameters are selected. (Abstract).

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Treyz is directed to an automobile personal computer system. Treyz discloses a wireless communication to an automobile personal computer system. (Abstract).

Losey is directed to an intelligent valet key, where a reduced number of vehicle access functions are permitted in valet mode (Abstract).

Weskow is directed to a vehicle security system with secure valet switch. To enter, e.g., system valet mode, the user must first enter a valid personal access code via a remote control transmitter. (Abstract).

The office action asserts that Murphy anticipates the invention as recited in independent claim 24. To the contrary, Murphy fails to set forth each and every element found in claims 24 and 25, as amended. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Murphy fails to teach or suggest, for example, "generating a command for activating a navigation privacy mode" or "wherein the given function accesses personal position information ..., to thereby protect stored personal position information from being disclosed when the navigation privacy mode is activated, although the vehicle can remain unchanged in any function and movement other than a function needing a use of the stored personal position information," or "when unpermitting the given function is determined, a prohibition state where the given function is prohibited although the vehicle can remain unchanged in any function and

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movement other than a function needing a use of the stored personal position information." (See, e.g., independent claim 24.) The examiner argues that Murphy's privacy mode is "the mode in which the use of the vehicle is restricted is entered into when the predetermined condition of identifying the user as a restricted user is established." To the contrary, Murphy fails to teach or suggest a navigation privacy mode, or determining unpermitting use based on personal position information, where the personal position information is not disclosed in the prohibition state but the other functions and movement of the vehicle are permitted. For example, Murphy discloses that operation of the vehicle can be restricted to location, velocity ranges, time interval, accumulated operation time, and/or mileage ranges. (Abstract). Accordingly, the invention as recited in claims 24 and 25 is not anticipated by Murphy. Therefore, it is respectfully submitted that the rejection under 35 USC 102(b) must be withdrawn.

To properly reject a claimed invention under 35 USC 103(a), the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, it is necessary to identify the reason why a person of ordinary skill in the art would have combined allegedly known elements in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.* No. 04-1350 (U.S. Apr. 30, 2007). The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The applicant provides herein a selection of some examples of limitations in the claims which are neither taught nor suggested by Murphy. The Office Action repeatedly urges that Murphy teaches the use of the given function using the user's personal information, by referring

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to "vehicle accessories" (citing portions of Murphy including col. 5, line 39). However, according to Murphy "as one of 12 Control Actions: ... (2) the system (temporarily) disables use of selected vehicle accessories, such as a winch, pump, cargo lift, cargo lock, dump mechanism, emergency lights or flashers, or door locks." (Col. 5, lines 33-41.) The office action's contention, however, begs the question as to why this provides a reason that someone skilled in the art would have protected the user's personal position information from being disclosed. Only a use of hindsight using the applicant's specification would have resulted in the recited invention.

The Office Action admits that Murphy "is silent on teaching optionally activating a privacy mode." (Office Action, page 4.) Recognizing that Murphy fails to teach and/or suggest the invention as claimed in independent claims 1, 11 and 13, Gormley is cited to remedy the deficiencies. Treyz, Losey, and/or Weskow are cited to remedy the deficiencies for Murphy and Gromley with respect to certain dependent claims.

Nevertheless, Gormley, Treyz, Losey, and/or Weskow fail to remedy such deficiencies. For example, none of the references teach or suggest "an unpermitting command for unpermitting the given function to thereby protect the stored personal position information from being disclosed when the navigation privacy mode is activated, although the navigation device can remain unchanged in any function other than a function needing a use of the stored personal position information." The disclosure of the personal position information is detrimental to protection of a user's privacy, as discussed in the present application. The examiner contends in connection with claim 27 that "Murphy teaches storing navigation information ... By allowing the user to only travel to and from work suggests the system has personal information regarding the user including information identifying the home of the user in order to restrict the user's travel." (Office action page 8.) This does not teach or suggest unpermitting the function to

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protect the stored personal position information from being disclosed (e.g., claim 1). To the contrary, according to Murphy, the information about the user's home is expressly disclosed.

Furthermore, even if Gormley's disclosure regarding "selectively activating a privacy mode such as a valet mode in order to restrict the operation of the vehicle" is combined with Murphy, the combination still fails to teach or suggest "unpermitting the given function to thereby protect the stored personal position information from being disclosed with the navigation privacy mode is activated" in the navigation device. For example, Murphy and Gormley operate on the vehicle itself, while in contrast claim 1 acts on the personal position information within the navigation device itself.

Hence, Murphy and Gormley, Treyz, Losey, and/or Weskow, alone or in combination, fail to teach or suggest the combination of features recited in independent claims 1, 11, 13 and 24, when considered as a whole.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 11, 13 and 24, but also because of additional features they recite in combination.

The applicant respectfully submits that, as described above, the cited art does not show or suggest the combination of features recited in the claims. The applicant does not concede that the cited art shows any of the elements recited in the claims. However, the applicant has provided specific examples of elements in the claims that are clearly not present in the cited art.

The applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the cited art as limiting to those specific features in isolation. Rather, for the sake of

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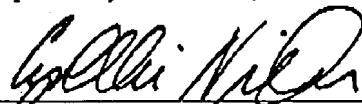
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simplicity, the applicant has provided examples of why the claims described above are distinguishable over the cited references.

In view of the foregoing, the applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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